

Appl. No. 10/001,894  
Amdt. sent January 12, 2006  
Reply to Office Action of December 20, 2005

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**REMARKS/ARGUMENTS**

Before this Amendment, claims 1-45 were pending. With this Amendment, to further emphasize distinctions over the cited art, Applicants amend independent claims 1, 8, 13, 15, 17, 24, 29, 31, 33, 37, 42, and 44, dependent claims 5, 6, 10, 11, 21, and 22, and add new claims 46-48.

In the Office Action mailed December 20, 2005 ("Office Action"), the Examiner rejected claims 1, 4, 7-9, 17, 20, 23-25, 33, and 36-38 under U.S.C. § 103(a) as being anticipated over Mao in view of Saur et al. The Examiner rejected claims 13, 29, and 42 under U.S.C. § 103(a) as being anticipated over Mao in view of Saur, further in view of Chen.

Applicants respectfully traverse.

**Substance of Telephone Interview**

Applicants thank the Examiner for the telephone interview of May 3, 2006 in which Applicants' representatives Eric Worthington (Reg. No. 50,910) and Sujit Kotwal (Reg. No. 43,336) presented differences between claim 1 and the Mao and Saur references. As discussed during the interview, Mao teaches an index only into a physical hardcopy document. Saur teaches only editing of video. In contrast, claim 1 is directed to using a paper document to retrieve electronically stored multimedia information and output portions of the multimedia information. As discussed, neither Mao or Saur or the combination teach or suggest using a paper document to retrieve electronically stored information.

To further emphasize distinctive aspects, Applicants have amended the independent claims to state that the multimedia information "comprises one or more of audio, image, or video information" to further distinguish from Mao. However, as stated below, Applicants believe that the Examiner has failed to state a *prima facie* case of obviousness, even without the amendments to the independent claims.

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Independent Claim 1

As amended, claim 1 recites:

1. A computer-implemented method of using a paper document to retrieve multimedia information stored in a multimedia document in electronic form, wherein one or more user-selectable identifiers are printed on the paper document, the method comprising:
  - receiving a first signal indicating selection of a first user-selectable identifier from the one or more user-selectable identifiers printed on the paper document;
  - responsive to receiving the first signal, identifying a portion of multimedia information stored by the multimedia document corresponding to the first user-selectable identifier; and
  - outputting the portion of the multimedia information corresponding to the first user-selectable identifier using an output device;

wherein the multimedia information comprises one or more of audio, image, or video information.

Claim 1 therefore states a method whereby a user-selectable identifier is printed on a paper document, and responsive to a selection of the identifier, a portion of the electronically stored multimedia information is output using an output device. In other words, in claim 1, the paper document is used to provide an input that is used to generate an output from the electronically stored multimedia document.

In contrast, Mao teaches an index into a hardcopy (non-electronic) document. Mao et al. teaches a "search assistant" (402) for generating and accessing a text-based electronic index. Search assistant 402 does not output the actual contents of the hardcopy document itself, but rather merely outputs index information (e.g. page numbers) that help the reader flip to the correct pages in the hardcopy document in its paper form.

The Examiner agrees that, at page 3 of the Office Action, Mao fails to disclose the step of outputting multimedia information. However, the Examiner states that Saur discloses outputting multimedia information (Saur page 176), and states that it would be obvious to combine Mao and Saur "since it would have allowed a user to search annotated multimedia information."

In contrast to the assertion of the Examiner, Applicants submit that (1) there is no motivation to combine the Mao and Saur references, (2) Mao teaches away from the proposed combination, and (3) the only motivation to combine is based on impermissible hindsight.

There must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. The teaching

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or suggestion to make the claimed combination must be found in the prior art and not based on applicant's disclosure. Impermissible hindsight must be avoided and the legal conclusion must be reached on the basis of the facts gleaned from the prior art. MPEP §2142.

(1) There is no motivation to combine Mao and Saur.

Applicants submit that there is no motivation to combine Mao and Saur. As noted above, Mao teaches an index into a hardcopy document. Mao states that users prefer hardcopy documents, because hardcopy documents "are pleasant to read" and "do not require network connectivity or depend on network speed." Mao opines that "books, even in technical areas, will be popular for a long time" (col. 1, line 64 - col. 2 line 2). As the Examiner agrees, there is no discussion whatsoever in Mao that the index or search assistant may be used to output electronically stored multimedia information, as recited in claim 1.

Saur, on the other hand, is directed merely to analysis and annotation of electronically stored video sequences, using electronic tools to retrieve the video sequences. Saur teaches methods for providing users with video content summaries and automatically extracting meaningful video content for annotation (page 176). However, there is no discussion in Saur of using a paper document to retrieve the electronically stored video information, as recited in claim 1. There is certainly no teaching or suggestion in Saur that a paper document such as that generated in Mao may be used for outputting portions of video sequences.

Therefore, because there is no suggestion or motivation in the references or elsewhere in the art to combine Mao and Saur, Applicants submit that the Examiner has not shown a *prima facie* case of obviousness.

(2) Mao teaches away from the proposed combination

Applicants submit that Mao teaches away from the Examiner's proposed combination. The point of Mao is not to electronically output the contents of a hardcopy document from an output device to the reader. Instead, Mao emphasizes the "distinct advantages" of having the reader physically handle and directly read the hardcopy document itself in its paper form (col. 1, line 64 - col. 2 line 2).

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Applicants thus submit that a person of ordinary skill in the art would not be motivated to combine Mao and Saur in the manner proposed by the Examiner. The combination proposed by the Examiner would actually defeat the purpose of Mao's invention, which is to assist the reader in accessing a hardcopy document in its paper form. Because Mao teaches away from the Examiner's proposed combination, Applicants submit that the Examiner has not shown a *prima facie* case of obviousness.

(3) The only motivation to combine is based on impermissible hindsight

As stated above, neither Mao or Saur teaches or suggests the combination proposed by the Examiner. Further, Mao in fact teaches away from the Examiner's proposed combination. Applicants therefore submit that the only motivation to combine must be based on impermissible hindsight.

In addition, Applicants submit that the principle of operation of either or both of Mao and Saur would need to be modified for the Examiner's proposed combination to work. "If the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious. *In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959)", MPEP §2143.01(VI). As noted, Mao teaches an index into a hardcopy document. Saur teaches electronic tools for editing or annotating electronically stored video information. The principle of operation of either or both of Mao and Saur would therefore need to be modified in order for the proposed combination to work, which makes the combination insufficient to state a *prima facie* case of obviousness.

Independent Claims 8, 15, 17, 24, 31, 33, 37, and 44

The arguments made above with respect to claim 1 apply with similar force to the rejection of claims 8, 15, 17, 24, 31, 33, 37, and 44. Therefore, Applicants submit that the Examiner has failed to state a *prima facie* case of obviousness with respect to claims 8, 15, 17, 24, 31, 33, 37, and 44.

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Further, with respect to the rejection of claims 8 (and 24 and 37 rejected on similar grounds), the Examiner stated at page 4 of the Office Action that Mao discloses "[r]equesting multimedia information corresponding to the first user-selectable identifier (Figure 4, item 410)."

However, Applicants submit that Mao does not teach this element of claim 8, 24, and 37 because Mao is directed to indexing hardcopy documents and not to "requesting multimedia information" as recited in claim 8. For example, column 5 lines 50-54 of Mao states, "A memory 412 coupled to the searching engine 410...stores indexing tables 420 which can be searched and used to provide indexing information to a reader of the hardcopy document." However, the indexing tables of Mao merely provide alphanumeric information, such as page number, for indexing into the hardcopy document. Mao does not teach or suggest "requesting multimedia information" as recited in claim 8. Further, as noted above with respect to claim 1, there is no motivation to combine the Saur reference with Mao, thus Saur does not correct this deficiency of Mao.

Independent claim 13, 29, and 42.

With respect to the rejection of independent claim 13 (and 29 and 42 rejected on similar grounds), the Examiner admitted at page 28 of the Office Action that Mao fails to disclose the second plurality of user-selectable identifiers being a subset of the first plurality of user-selectable identifiers, but states that Chen discloses organizing items into subsets (Figure 3, section 3).

Chen is directed to video database management, providing a browsing or searching paradigm for organizing electronically stored video data (Chen, page 148). Like Saur, Chen is directed to using electronic tools for managing electronically stored information. There is no discussion or suggestion in Chen of using a paper document as an input mechanism by which portions of multimedia information may be output, as recited in claims 13, 29, and 42 in one form or another. Therefore, Applicants submit that there is no motivation to combine Mao

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with Saur and Chen, that Mao teaches away from the Examiner's proposed combination, and the only motivation to combine is based on impermissible hindsight.

Dependent claims

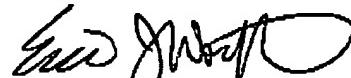
If an independent claim is nonobvious under 35 U.S.C. §103, then any claim depending therefrom is nonobvious, *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988), MPEP §2143.03. Claims 2-7, 9-12, 14, 16, 18-23, 25-28, 30, 32, 34-36, 38-41, 43, 45, and 46 depend from independent claims and includes all the limitations of its respective independent claim. Thus, for at least the reasons stated above with regard to the independent claims, dependent claims 2-7, 9-12, 14, 16, 18-23, 25-28, 30, 32, 34-36, 38-41, 43, 45, and 46 are also believed to be patentable.

CONCLUSION

In view of the foregoing, Applicants believe all claims now pending in this Application are in condition for allowance. The issuance of a formal Notice of Allowance at an early date is respectfully requested.

If the Examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned at 650-326-2400.

Respectfully submitted,



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